

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on May 19, 2003, the Examiner rejected claims 10-13, 15-16 and 18-19 under 35 U.S.C. §102(e) as being anticipated by Anderson et al (U.S. Patent No. 6,058,380, hereinafter "Anderson"), rejected claims 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Thomson et al (U.S. Patent No. 4,948,174, hereinafter "Thomson"), and rejected claims 17 and 21 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Ferguson et al (U.S. Patent No. 6,336,094, hereinafter "Ferguson"). Accordingly, Applicant provides the following:

Rejection under 35 U.S.C. § 102

The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

“... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Applicant respectfully submits that Anderson does not teach every aspect of the claim set as provided herein and therefore does not anticipate the claims of the present invention. In fact, Anderson teaches away from the limitations of the claim set for the present invention. Each independent base claim and every dependent claims of the present invention includes a limitation relating to initiating generation of an electronic payment file at the customer computer system to pay an amount owed to the vendor. Anderson does not teach or suggest this limitation.

Anderson teaches “a system and a method that permits an intermediary, e.g., a bank, having EDI capabilities to electronically process vendor invoice information on behalf of a customer that does not have EDI capabilities.” (see Col. 2, lines 8-12) In contrast, the present invention claims a method for electronically initiating a payment of an amount owed to a vendor

from a customer computer system regardless of whether the vendor utilizes an electronic payment technology.

Anderson teaches use of an intermediary that can “(1) receive invoice information by any of a variety of methods, including electronic, from a vendor on behalf of a customer; (2) automatically review the invoice information, resulting in either approval of the invoice information or identification of unusual billing circumstances; (3) notify the customer of any unusual billing circumstances; (4) electronically transmit a file to the customer that is compatible with customer's AP system; (5) pay the vendor by any of a variety of methods, including electronic, on the due date; and (6) maintain historical information, which permits trends analysis and management reporting.) (see Col. 2, lines 23-34) In contrast, the claims of the present invention include a limitation relating to using the third-party electronic payment processing center to effectuate the payment of the amount owed to the vendor regardless of whether the vendor utilizes an electronic payment technology, wherein the step for using the third-party electronic payment processing center to effectuate the payment comprises steps for using an electronic payment technology when available; and using a printed check when no electronic payment technology is available.

Further, Anderson specifically teaches away from a initiating a payment of an amount owed to a vendor from a customer computer system as claimed by the present invention. Specifically, Anderson teaches “replacing three mail cycles (vendor to customer, customer to AP department and AP department to vendor)”. (see Col. 2, lines 35-50) In contrast, the claims of the present invention include limitations relating to initiating generation of an electronic payment file at the customer computer system to pay an amount owed to the vendor; transmitting the electronic payment file from the customer computer system to a third-party electronic payment

processing center, wherein the step for transmitting the electronic payment file initiates payment of the amount owed to the vendor; and using the third-party electronic payment processing center to effectuate the payment of the amount owed to the vendor regardless of whether the vendor utilizes an electronic payment technology, wherein the step for using the third-party electronic payment processing center to effectuate the payment comprises steps for using an electronic payment technology when available; and using a printed check when no electronic payment technology is available.

Accordingly, Applicant respectfully submits that Anderson does not teach every aspect of the claimed invention either explicitly or impliedly as required by M.P.E.P. 706.02. In fact, Anderson teaches away from the claimed invention by replacing the interactions of vendor to customer, customer to AP department and AP department to vendor. (see Col. 2, lines 35-50) Accordingly, for at least the reasons provided above, Applicant respectfully submits that Anderson does not teach every aspect of the claim set as provided herein and therefore does not anticipate the claim set. Thus, Applicant respectfully submits the claim set provided herein overcomes all rejections made by the Examiner in the Office Action under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Thomson, and rejected claims 17 and 21 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Ferguson. Applicant respectfully submits that the 35 U.S.C. § 103(a) obviousness rejections of the claim set as provided herein are improper for at least the following reasons: First, M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).(emphasis added)

Applicant respectfully submits that the 35 U.S.C. § 103(a) obviousness rejection of the claim set as provided herein is improper because the prior art references do not teach or suggest all the claim limitations. As provided above, each of the independent base claims of the claim set, and all dependent claims, includes a limitation relating to initiating generation of an electronic payment file at the customer computer system to pay an amount owed to the vendor. Anderson does not teach or suggest this limitation.

Anderson teaches "a system and a method that permits an intermediary, e.g., a bank, having EDI capabilities to electronically process vendor invoice information on behalf of a customer that does not have EDI capabilities." (see Col. 2, lines 8-12) Thomson teaches methods and systems for affecting the accounting functions of debiting and crediting a bank's account records based upon the combination of data from two or more sources. (Abstract) Ferguson teaches a method for processing a file containing a financial statement. (Abstract) These are provided in contrast to the claims of the present invention, which are directed to a method for electronically initiating a payment of an amount owed to a vendor from a customer computer system regardless of whether the vendor utilizes an electronic payment technology.

As provides above, Anderson specifically teaches away from a initiating a payment of an amount owed to a vendor from a customer computer system as claimed by the present invention. Specifically, Anderson teaches "replacing three mail cycles (vendor to customer, customer to AP

department and AP department to vendor)". (see Col. 2, lines 35-50) In contrast, the claims of the present invention include limitations relating to initiating generation of an electronic payment file at the customer computer system to pay an amount owed to the vendor; transmitting the electronic payment file from the customer computer system to a third-party electronic payment processing center, wherein the step for transmitting the electronic payment file initiates payment of the amount owed to the vendor; and using the third-party electronic payment processing center to effectuate the payment of the amount owed to the vendor regardless of whether the vendor utilizes an electronic payment technology, wherein the step for using the third-party electronic payment processing center to effectuate the payment comprises steps for using an electronic payment technology when available; and using a printed check when no electronic payment technology is available. Further, neither Thomson nor Ferguson teach or suggest such limitations.

Thus, Applicant respectfully submits that none of the references cited by the Examiner, alone or in any combination, teach or suggest the limitations provided in the claims of the present invention relating to initiating generation of an electronic payment file at the customer computer system to pay an amount owed to the vendor; transmitting the electronic payment file from the customer computer system to a third-party electronic payment processing center, wherein the step for transmitting the electronic payment file initiates payment of the amount owed to the vendor; and using the third-party electronic payment processing center to effectuate the payment of the amount owed to the vendor regardless of whether the vendor utilizes an electronic payment technology, wherein the step for using the third-party electronic payment processing center to effectuate the payment comprises steps for using an electronic payment technology when available; and using a printed check when no electronic payment technology is

available. Accordingly, Applicant respectfully submits that for at least reasons provided herein, the references cited by the Examiner do not establish a *prima facie* case of obviousness.

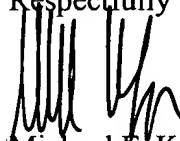
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set of the present invention overcomes all rejections made by the Examiner.

CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicants therefore request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 19 day of August, 2003.

Respectfully submitted,



Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

DBT:lc

::ODMA\PCDOCS\DOCS\686503\1